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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,216	07/08/2003	Marie T. Fishman	21675	3121

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EXAMINER


WRIGHT, ANDREW D

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/617,216	Applicant(s) FISHMAN, MARIE T. 	
	Examiner Andrew Wright	Art Unit 3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28-38 is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-20, 22-27, 39, 40 and 42-45 is/are rejected.
- 7) ☒ Claim(s) 8, 21 and 41 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/12/03</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

1. Claim 44 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 44 depends from claim 39. Claim 39 recites that the information medium is substantially water resistant.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 5, 6, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsui (US 6,085,449). The body is (10) with cavity (26). The strap assembly includes strap member (16) and pair of clasps (18). Each clasp is coupled to an opposite end of the strap. Each clasp is directly and removably coupled to the body.

4. Regarding claim 2, the clasps are rotatably coupled to the body.

5. Claim 5, upper section is (11a) and lower section is (11b).

6. Claim 6, upper section is heat sealed to lower section. The bead (22) of the heat seal constitutes a seal that is substantially water resistant.

7. Regarding claim 13, it is noted that claim 1 does not positively recite the information medium. Rather, the information medium is recited as an intended use. A

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recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the cavity (26) is capable of carrying an information medium. Furthermore, the cavity is capable of carrying an information medium that is substantially water resistant. It is suggested that applicant positively recite the information medium as a structural component of the invention, and not as an intended use.

8. Regarding claim 14, the cavity is capable of carrying information medium (14) which is a badge and inherently has identification information.

9. Claims 1, 2, 3, 4, 12-17, and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Houlihan (US 5,577,007). Houlinhan shows a bracelet with a body (6) and strap (14) and pair of clasps (32,34). The body is a watch casing which inherently has an internal cavity. The clasps are coupled to opposite ends of the strap by pins (column 2, lines 55-58). The clasps are directly coupled to the body by pins or screws (36, 37, 38, 39). The use of screws constitutes removable coupling of the strap to the body.

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10. It is noted that the recitation "the cavity being configured to store and protect an information bearing medium..." is an intended use recitation. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the watch case (6) inherently has a cavity. The cavity, regardless of how small it may be, could be used to store an information medium with information about the individual. It is suggested that applicant positively recite the information medium, and positively recite that it is located within the cavity.

11. Claim 2, the clasps (32, 34) are rotatably coupled to the body (column 2, lines 45-48).

12. Claim 3, clasp (32) has a pair of fingers (32a). Each finger has a hole for receiving the pin (36 or 37). The fingers are splayable. Clasp (34) also has fingers with holes.

13. Regarding claim 4, applicant has recited "[the] fingers formed of a material having a plastic memory." In lines 9-14 on page 8 of the specification, applicant describes this as the fingers are "resilient" and the fingers "will return to their original position due to the memory of the plastic material." What applicant has described is elastic deformation. All materials, even the hardest metals, inherently have a range of

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elastic deformation. Applicant has not recited a range of "plastic memory". Therefore, any material used for clasps (32, 34) in the Houlihan invention necessarily meets the broad limitation.

14. Claim 12, clasps (32, 34) each have a pair of fingers that define an elliptical area for receiving the body.

15. Claims 13 and 14, as recited above the information medium is not positively recited. The Houlihan case (6) is capable of carrying an information medium that is water resistant and that has identification information on it.

16. Claim 15, Houlihan shows a body that inherently has a cavity that is capable of storing an information medium. Houlihan shows a strap and clasps. Each clasp has splayable fingers. Each finger has a hole through which screw (e.g. 36) passes to connect the clasp to the body. The screw is considered part of the body. Therefore the hole in the arm is capable of receiving at least a portion of the body.

17. The limitations of claims 16, 17, and 25-27 are present in Houlihan as already described with respect to claims 1-14.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 1, 5, and 7, and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houlihan (US 5,577,007) in view of Houlihan (US Des. 316,983).

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Houlihan ('007) shows a watch with a strap and body that reads on claim 1, as described above. Houlihan ('007) does not disclose details about the body (6).

Houlihan ('983) shows a design of a watch body. It is well known and common to construct a watch body from an upper section and a lower section that are joined together. Houlihan ('983) shows a watch body with upper and lower sections that join to form the body. As best seen in figures 1, 4, and 5, each of the upper and lower sections has a semi-circular protruding arm portion that is in the area where the wrist band is normally attached to the watch. Each protruding arm portion has a planar mating surface, and a semicircular cross section (see figures 4 and 5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Houlihan ('007) by using the body of Houlihan ('983) the motivation would be to use a casing that provides the compass features shown by Houlihan ('983).

20. The limitations of claims 18-20 and 22-24 are present in Houlihan ('007) modified in view of Houlihan ('983) as described above. Specifically regarding claim 19, it is well known and common to provide watch casings with a seal to provide water resistance. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Houlihan ('007) by providing a seal for water resistance. The motivation would be to allow the user to use the watch in wet environments.

21. Claims 39, 40, and 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larson (US 3,645,023). Larson shows a bracelet with information bearing medium (60). Tether (26a) constitutes a body with an upper section and a

lower section. The tether is looped causing the upper section and lower section to define a cavity in which a portion of the information medium (60) is stored (figure 5). The free end of the upper section is a protruding portion, and the free end of the lower section is a protruding portion. Clasp (24) clasps the protruding portions together and couples the body to the bracelet strap (22). Larson does not disclose that the information medium is substantially water resistant. Larson is silent as to the material of the medium (60). Therefore one wishing to make and use the invention would necessarily need to decide upon a material. It is well known and common to make identification bearing mediums water resistant for the purpose of preventing degradation of the medium. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the medium (60) from a substantially water resistant material. The motivation would be to provide a resilient information bearing medium that does not easily degrade. Larson does not disclose the recited method steps. The method steps, however, are inherent in the making and use of the Larson invention. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to devise the recited method steps. The motivation would be to make and use the Larson invention.

22. Regarding claim 40, the flexibility of the tether (26a) results in it being rotatable about the strap.

23. Claim 42, the clasp (24) has a pair of splayable fingers. The fingers necessarily have some degree of elastic deformation.

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24. Claim 43, the tether (26a), including the upper and lower portions, will resist water from contacting the medium (60) at least in the area where it directly contacts the medium.

25. Claim 44, it was already discussed that it would be obvious to make the medium water resistant.

26. Claim 45, the information medium relates to identification.

Allowable Subject Matter

27. Claims 28-38 are allowed.

28. Claims 8, 21, and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

29. Any inquiry concerning this communication should be directed to examiner Andrew D. Wright at telephone number (703) 308-6841. The examiner can normally be reached Monday-Friday from 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano, can be reached at (703) 308-0230. The fax number for official communications is 703-872-9306. The fax number directly to the examiner for unofficial communications is 703-746-3548.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew D. Wright
Patent Examiner
Art Unit 3617

Hz 9-10-04
ANDREW D. WRIGHT
PRIMARY EXAMINER